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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,206	12/20/2001	Caimi Luigi	08719.0196	6089
7590	02/20/2004		EXAMINER	
Finnegan, Henderson, Farabow Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			JACKSON, MONIQUE R	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/022,206	LUIGI ET AL. <i>eb</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Monique R Jackson	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 December 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed 12/8/03 has been entered. Claims 33-42 have been canceled.  
Claims 21-32 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of WO'288 for the reasons recited in the prior office action and restated below.

The admitted prior art teaches an electric cable for medium or high voltage electric energy transportation or distribution comprising at least one conductor and at least one insulating layer or one or more coverings formed of a crosslinked polymer material or elastomer but does not teach that the coverings or insulating layer comprise the instantly claimed elastomer composition (Page 1.) However, as previously discussed, WO'288 teaches an elastomer composition that reads upon the instantly claimed composition wherein WO'288 further teach that the composition provides improvements in terms of mechanical properties such as compression set resistance with respect to other thermoplastic elastomers or vulcanized rubbers and may be utilized in producing various fabricated articles including tubing, seals, and extruded profiles (Abstract; Pages 1-3; Page 15, lines 8-11.) Hence one having ordinary skill in the art at the time of the invention would have been motivated to utilize the elastomer composition taught by WO'288, having improved cure and mechanical properties, as the polymer insulating layer in the invention taught by the admitted prior art, given the reasonable expectation of success.

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of WO'288 and in further view of EP 0 893 802 A1 (EP'802) for the reasons recited in the prior office action and restated below.

The teachings of the admitted prior art in view of WO'288 are discussed above. Though the admitted prior art teaches that the electric cable includes one or more coverings including an insulating layer, the admitted prior art does not teach the incorporation of at least one insulating layer and at least one layer including the polymer composition and a conductive filler to provide semiconductive properties. However it is well known in the art that an electric cable for medium voltages typically comprises insulating and semiconductor layers as taught by EP'802 (Page 2, lines 3-40; Page 3, lines 33-53; Figure 1) wherein the semiconductor layer(s) include a conductive filler dispersed therein to provide semiconductive properties to the layer(s). Hence, it would have been obvious to one having ordinary skill in the art to include conductive filler in one of the covering layers taught by the admitted prior art in view of WO'288 to incorporate conductive filler in at least one of the polymer covering layers of the invention taught by the admitted prior art in view of WO'288 to provide semiconductive properties to at least one of the coating layers as is typical and well known in the art as taught by EP'802.

***Response to Arguments***

5. Applicant's arguments filed 12/8/03 have been fully considered but they are not persuasive. First, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of

ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the admitted prior art (the primary reference) teaches an electric cable for medium or high voltage electric energy transportation or distribution comprising at least one conductor and at least one insulating layer or one or more coverings formed of a crosslinked polymer material or elastomer. Though the admitted prior does not teach that the insulating or covering layer comprises the elastomer composition as instantly claimed, the admitted prior art does refers to ethylene copolymers and further states that the fillers are typically added to improve the mechanical strength of the insulating material. However, WO'288 discloses an ethylene copolymer elastomer composition that reads upon the instantly claimed composition wherein WO'288 specifically teach that the composition provides improvements in terms of mechanical properties such as compression set resistance with respect to other thermoplastic elastomers or vulcanized rubbers and may be utilized in producing various fabricated articles. Though WO'288 does not specifically disclose the use of the elastomer composition for electric cables as argued by the Applicant, the Examiner takes the position that WO'288 provides motivation to utilize the disclosed ethylene copolymer

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elastomer composition in place of the crosslinked polymer material or ethylene copolymer elastomers taught by the admitted prior art because it provides improvements in terms of mechanical properties such as compression set resistance with respect to other thermoplastic elastomers or vulcanized rubbers. Further, the Applicant's arguments that the patentee of WO'288 would have explicitly stated that the elastomer composition was suitable for electrical cables if that was the case, and hence the elastomer composition of WO'288 is allegedly not suitable for the electric cable products of the instant invention, are not persuasive. The Examiner notes that WO'288 clearly states that the fabricated articles made from the thermoplastic elastomers include, "**without limitations**", the list at Page 15, and hence may include various other fabricated articles that are not listed. Further it is interesting to the Examiner that the Applicant argues that the elastomer composition of WO'288 is not suitable for the electric cable product instantly claimed considering the elastomer composition of WO'288 is the same as the elastomer composition instantly claimed. Hence, for the above reasons, the Examiner maintains that the invention would have been obvious over the admitted prior art in view of the secondary references cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
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February 10, 2004